

40055-0001

10/635,382

REMARKS

This is a full and timely response to the final Official Action mailed February 24, 2006 and the Decision on Appeal mailed June 8, 2007. Reconsideration of the application in light of the following remarks is respectfully requested.

Request for Continued Examination:

Applicant hereby requests Continued Examination for this application and entry and consideration of this amendment consequent thereto.

Claim Status:

Claims 16-27 were withdrawn under a previous restriction requirement and cancelled without prejudice or disclaimer.

By the present amendment, various claims are amended and claim 29 is cancelled without prejudice or disclaimer. Thus, claims 1-15, 28, and 30-32 are currently pending for further action.

35 U.S.C. § 112, Second Paragraph:

The Office Action rejected claim 12 under 35 U.S.C. § 112, second paragraph. While Applicant does not agree that claim 12 was indefinite as previously presented, claim 12 has been amended herein to clarify what is being claimed. Following entry of this amendment, the rejection of claim 12 under § 112 should be reconsidered and withdrawn.

40055-0001

10/635,362

Prior Art:

With regard to the prior art, claims 1-14 and 28-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 1,569,486 to Hardin ("Hardin") taken alone. In an alternative rejection, claims 1-5, 8-15 and 28-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 6,735,831 to Greiwe et al. ("Greiwe"). In still another alternative rejection, claims 1-3, 6-11, 28 and 30-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 668,582 to McClintock ("McClintock"). For at least the following reasons, these rejections are all respectfully traversed.

Applicant's specification describes "a method and system for storing and preserving writings and memoranda to enhance the value of an heirloom. The writings and memoranda may be stored and preserved in a variety of methods. In one embodiment, the writings will be stored in and/or on a piece of furniture specifically designed for storing such writings." (Applicant's specification, paragraph 0017).

In the embodiment claimed, the writings are made directly on a wooden surface of a piece of furniture that is made from wood and has a wooden surface specifically intended to receive a handwritten writing. As stated in Applicant's specification, "the writing surface may be any type of wood, plastic, metal, ceramic, marble or other material, which may be marked." (*Id.*) (emphasis added). "More specifically, the writings may be stored on planks, tablets or drawers built into, on or attached to (e.g., hinged to) the piece of furniture." (Applicant's specification, paragraph 0018).

40055-0001

10/635,362

Claim 1 now recites:

A method for storing handwritten writings on a piece of furniture made of wood, said method comprising:

preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made; and

storing said handwritten writings on said piece of furniture,

wherein said furniture comprises a member comprising a surface of said wood

that is specifically configured to permanently receive said handwritten writings.

(emphasis added).

Thus, claim 1 expressly recites “preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made.” Moreover, claim 1 recites “a surface of said wood that is specifically configured to permanently receive said handwritten writings.”

In contrast, the three prior art references cited generally do not teach or suggest the claimed method in which one prepares a handwritten writing “directly on the wood of which said piece of furniture is made,” where “a surface of said wood ... is specifically configured to permanently receive said handwritten writings.” Rather, the prior art references cited either do not teach or suggest handwritten writings or merely teach temporarily securing a piece of paper that may bear handwriting to some furniture-like structure.

For example, Hardin teaches a desk in which sheets of paper may be kept under a transparent plate. According to Hardin, “the sheets bearing the memoranda, data, or other subject-matter are placed between the mat and glass plate for inspection through the transparent plate.” (Hardin, lines 82-87). Hardin does not teach or suggest the claimed method in which handwritten writings are stored on a surface of a material used to construct a piece of furniture that is configured to permanently receive such writings.

40055-0001

10/635,362

Greiwe teaches a "cremation remains container" that includes a memorial plaque (70). However, the plaque taught by Greiwe is not "handwritten." Griewe does not teach or suggest that the plaque can be handwritten. One of skill in the art would not conclude that the plaque taught by Griewe is handwritten. To the contrary, viewing the illustrations provided by Greiwe, the plaque (70) is clearly *not* handwritten. Thus, Griewe does not teach or suggest the claimed method of storing handwritten writings with furniture having a surface configured to permanently receive handwritten writings. There is no teaching or suggestion in Griewe of a surface specifically configured to permanently receive *handwritten* writings as claimed.

Lastly, McClintock does not teach or suggest the claimed method for storing handwritten writings on a piece of furniture, where the furniture comprises "*a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*" Rather, McClintock, merely teaches a "tablet file case" in which "file drawers" (4) include fasteners (17) that are used to secure papers including "different printed forms" in the file drawer (4). (McClintock, page 2, lines 1-17).

Thus, McClintock, similar to Hardin, merely teaches a method of securing printed paper forms to structure, in this case a file drawer. None of the cited prior art references teach or suggest the claimed method of "preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made," where a surface of said wood ... is specifically configured to permanently receive said handwritten writings."

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA

40055-0001

10/635,362

1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejections based on Hardin, Greiwe and McClintock should be reconsidered and withdrawn.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope of the prior art, as evidenced by the cited references, did not include the claimed method of storing handwritten writings directly on a wooden surface of a piece of furniture made of wood, said method comprising: preparing one or more handwritten writings by hand directly on the wood of which said piece of furniture is made; ... wherein said furniture comprises a member comprising a surface of said wood that is specifically configured to permanently receive said handwritten writings." There is no such teaching or suggestion in the prior.

This difference is significant because, as explained, Applicant's specification "describes a method and system for storing and preserving writings and memoranda to enhance the value of an heirloom." (Applicant's specification, paragraph 0017). The prior art does not address nor provide this advantage as does the claimed method.

Consequently, the cited prior art references cannot support a rejection of Applicant's amended claims under *Graham* and § 103. Therefore, all rejections of Applicant's claims should be reconsidered and withdrawn.

40055-0001

10/635,362

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: August 8, 2007

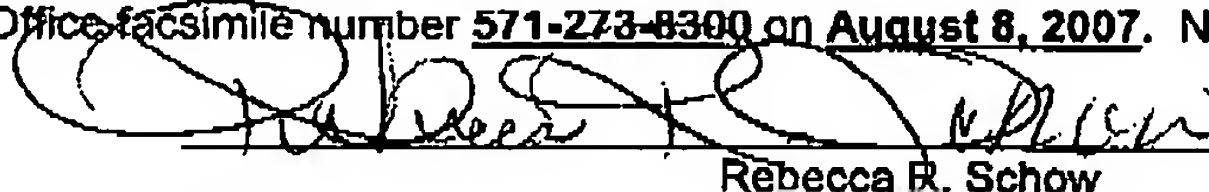


Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095
(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office, facsimile number ~~571-273-8300~~ on August 8, 2007. Number of Pages: 17


Rebecca R. Schow